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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,213	03/20/2001	Minoru Asakawa	01147/LH	1974
1933	7590	07/08/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			POON, KING Y	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/813,213	<b>Applicant(s)</b> ASAKAWA ET AL.	
	<b>Examiner</b> King Y. Poon	<b>Art Unit</b> 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-12 is/are rejected.
- 7) ☒ Claim(s) 13-17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 18-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/20/2005.

### *Specification*

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 5-7, 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Takami et al (Pub. US 2002/0027667).

Regarding claim 1: Takami teaches an image-forming apparatus (fig. 1), for forming an image on recording material (recording paper, paragraph 56), an area of

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which is wider than that of a standard fixed-form size (e.g.,  $X_i$  greater than 270mm is being set as  $X_{s1}=270\text{mm}$ , which is group 1 regular/standard size recording paper, fig. 28A) having a predetermined fixed-form size (e.g., A3-P, fig. 28A), based on an original image recorded on a document (paragraph 4), comprising: a plurality of recording material storing devices (plural free size cassettes, paragraph 0114), in each of which said recording material can be stored; an input section (operation panel, paragraph 57, and the program that matches the entered size to a regular/standard size, paragraph 84) to establish information in regard to a size of said recording material, which is stored in one of said recording material storing devices, as setting information corresponding to each of said recording material storing devices; a memory section (the memory that used to store user entered size and programmed material such as fig. 28A-C and paragraph 57) to store said setting information corresponding to each of said recording material storing devices; and a control section (128, fig. 1) to determine controlling conditions (paragraph 83) based on said setting information and to control operations of said image forming apparatus based on said controlling conditions; wherein said setting information include said standard fixed-form size (abstract, fig. 28A, paragraph 84) and longitudinal and lateral lengths (fig. 28 B, paragraph 64) of said recording material.

Regarding claim 3: Takami teaches wherein, at a first step, said standard fixed-form size is inputted into said input section as said setting information (the program step that programs the information of fig. 28B), and, at a second step (paragraph 57), said

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longitudinal and lateral lengths of the recording material are inputted into said input section as said setting information.

Regarding claim 5: Takami teaches a displaying section to display said setting information in a manner such that said setting information clearly corresponds to each of said recording material storing devices (paragraph 125).

Regarding claim 6: Takami teaches wherein said displaying section displays information in regard to said standard fixed-form size and information of size larger than said standard fixed-form size (paragraph 113, no size data is information that the size of the recording material is not designated yet; which is information in regard to said standard fixed-form size and information of size larger than said standard fixed-form size).

Regarding claim 7: Takami teaches an image-forming apparatus (fig. 1), for forming an image on recording material (recording paper, paragraph 56), an area of which is wider than that of a standard fixed-form size (e.g.,  $X_i$  greater than 270mm is being set as  $X_{s1}=270\text{mm}$ , which is group 1 regular/standard size recording paper, fig. 28A) having a predetermined fixed-form size (e.g., A3-P, fig. 28A), based on an original image recorded on a document (paragraph 4), comprising: a plurality of recording material storing devices (plural free size cassettes, paragraph 0114), in each of which said recording material can be stored; an input section (operation panel, paragraph 57, and the program that matches the entered size to a regular/standard size, paragraph 84) to establish information in regard to a size of said recording material, which is stored in one of said recording material storing devices, as setting information corresponding

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information corresponding to each of said recording material storing devices; a memory section (the memory that used to store user entered size and programmed material such as fig. 28A-C and paragraph 57) to store said setting information corresponding to each of said recording material storing devices; a control section (128, fig. 1) to determine conveyance controlling conditions, by which a conveyance mode of said recording material, fed from one of said recording material storing devices, is determined, based on said setting information, and to control operations of said image-forming apparatus based on said conveyance controlling conditions (paragraph 79, 83, 84, and 85); wherein said setting information include said standard fixed-form size (abstract, fig. 28A, paragraph 84) and longitudinal and lateral lengths (fig. 28 B, paragraph 64) of said recording material, and said conveyance controlling conditions are determined based on the longitudinal and lateral length of the recording material (paragraphs 79, 84, 85).

Regarding claim 9: Takami teaches wherein said control section calculates an approximate fixed-form size (fig. 6, paragraph 84), which does not exceed said longitudinal and lateral lengths (paper bigger than A3 -P and A4 L (approximate fixed form size) is being matched to group I according than fig. 6, fig. 28A), but is approximate to said longitudinal and lateral lengths, and said control section calculates said conveyance controlling conditions based on other conveyance controlling conditions corresponding to said approximate fixed-form size.

Regarding claim 10: Takami teaches wherein said other conveyance controlling conditions corresponding to said approximate fixed-form size are given in advance (the printer is programmed before being used by users of paragraph 57).

Regarding claim 11: Takami teaches wherein said approximate fixed-form size is separately determined with respect to each of longitudinal and lateral directions (paragraph 57).

Regarding claim 12: Takami teaches wherein said control section compares said standard fixed-form size with a most approximate fixed-form size, (paragraph 84) which does not exceed said longitudinal and lateral lengths, but most approximate to said longitudinal and lateral lengths, to determine said standard fixed-form size as said approximate fixed-form size when said standard fixed-form size is equal to said most approximate fixed-form size, or to determine said most approximate fixed-form size as said approximate fixed-form size when said standard fixed-form size is smaller than said most approximate fixed-form size (paper bigger than A3 –P and A4 L (approximate fixed form size) is being matched to group I according than fig. 6, fig. 28A).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 2, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takami as applied to claims 1, 7 above, and further in view of Takaoka (US 5,247,370).

Regarding claims 2, 8: Takami does not teach wherein the input section establish a type of the recording material as the setting information, corresponding to each of the recording material storing devices.

Takaoka, in the same area of printing using recording material storing devices, teaches the input section (the interface that programs the printer to recognized different type of paper) establish a type (column 3, lines 1-10, column 8, lines 21-40) of the recording material as the setting information.

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Takami to include: the input section establish a type of the recording material as the setting information, corresponding to each of the recording material storing devices.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified Takami by the teaching of Takaoka because of the following reasons: (a) it would have allowed users to print with different type of paper and (b) it would have allowed the printer to control the different type of paper such that user's print job correctly printed.

***Allowable Subject Matter***



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7. Claim 4, 13-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is 571-272-7440. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 27, 2005

  
KING Y. POON  
PRIMARY EXAMINER